

REMARKS

The following remarks are made in response to the Office Action mailed November 6, 2006, in which claims 1-20 were rejected. With this Response, claims 1, 9 and 19 have been amended. Claims 1-20 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1, 3, 4, 9-11, 15 and 19 under 35 U.S.C. § 102(b) as being anticipated by Robinson, et al. (U.S. Patent No. 5,850,584).

The Office Action states in part:

Re claims 1, 9-11 and 19: Robinson teaches a printer system wherein with input from the operator by the UI 14, the image processing parameters of IPS 112 can be changed to produce different types/quality of images, which can be displayed on the UI 14 prior to printing. Using this ability to change image processing techniques, a range of image processing settings can be selected by the operator for a particular job or page (col. 6, lines 27-34). Inputting by the operator shows receiving a resource request at the printer, and the resource request including a request for at least one of use and a right to use of a selected at least one enhanced printer operational resource. Robinson further teaches that standard CMYK colorants are used, but non-standard or special colorants such as green and orange can be used to extend the printer gamut (col. 7, lines 8-10). Such teaching teaches that the printer includes operation resources comprising core printer operation resources and enhanced printer operational resources. Robinson discloses that UI 14 enables an operator to control and monitor various operator adjustable functions and maintenance activities. The operator actuates the appropriate keys on UI 14 to adjust the parameters of a print job. The output signal from UI 14 is transmitted to ESS 11. ESS 11 is programmable microprocessor system. ESS 11 conventionally controls all machines steps and functions including operation of document feeders, document and print sheet deflectors or gates, sheet feeder drives, downstream finishing device, etc. (col. 3, lines 30-46). Robinson further discloses that documents transmitted from workstation 4 to ESS 11 are electronically generated or retrieved, and IPS 112 receives a contone image and decomposes the contone image to a raster image (col. 3, lines 62-col. 4, lines 3). Such disclosure teaches operating the printer according to the resource request including at least one of use of and right of use of the selected at least one enhanced printer operation resource. Robinson also determining [sic] the cost of materials to be consumed based on the change of the at least one image processing parameters (col. 6, lines 33-38 and col. 8, lines 22-25), which teaches initiating a payment transactions based on the operating step, wherein the payment transaction includes a charge calculated as function of enhanced printer operational resource request.

Under 35 U.S.C. § 102, the cited reference must show each and every feature of the claimed invention. Extension of or speculation as to the cited teaching is permitted only when *necessarily present* in the disclosed apparatus or method. In other words, if a particular feature is not specifically disclosed it can only be relied upon under 35 U.S.C. § 102 if and

only if such feature is necessarily present in the disclosed apparatus or method. See, *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”), and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the ... claim”).

The Office Action finds unpersuasive Applicants’ earlier submitted argument that Robinson fails to teach or suggest a charge calculated as a function of the request for the use or right of use of an enhanced printer operational resource. Specifically, the Office Action notes “Although the cost [in Robinson] includes core printer operational resources, the claim does not recite that the charge only includes the enhanced printer operational resource request.” (Office Action mailed November 6, 2006, at pages 9-10).

With this Response, independent claims 1, 9 and 19 have been amended. Specifically, independent claims 1 and 19 (setting forth that the printer operational resources comprise *core* printer operational resources and *enhanced* printer operational resources) are amended to specify that **the payment transaction includes a charge calculated *only* as a function of the *enhanced* printer operational resource request**. Independent claim 9 similarly divides printer operational resources into a *first* resource set (e.g., a core resource set) and a *second* resource set (e.g., an enhanced resource set). Claim 9 is amended to specify that **a payment transaction is initiated *only* when the requested printer operational resource is a member of said *second* set**.

The amendments to claims 1, 9 and 19 are supported in the specification. For example, the application states “if a user 10 utilizes core level resources, i.e., resources for which there is no additional charge, the transaction is simplified and no use report 22 need be generated and resource vendor 14 need not be contacted. Generally, use report 22 and interaction with resource vendor 14 is a result of user 10 utilizing resources for which there is a fee, i.e., resources beyond a core set of resources.” (Page 4, lines 21-24). The instant application further describes dividing printer resources into layers to stratify price levels, and states, “A core layer 70 contains the basic printer resourced needed to print standard output, e.g., frequently used resources, *for which there is no fee*.” (Page 6, lines 29-31, emphasis

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added). Thus, the initiation of a payment transaction having a charge only for use of enhanced resources is clearly understood from the specification.

Robinson et al. fails to fails to teach or suggest a charge calculated *only* when an “enhanced printer operational resource” is used, as opposed to a charge for the printed product generally (including calculating a charge for “core” operational resources). Further, such limitations are not *necessarily present* in Robinson et al. Robinson et al. teaches that the user selects an image of a desired quality, and costs are then calculated based on the amount of materials consumed for that job (col. 6, lines 34-36), the paper used for the job (col. 7, lines 47-49), and the type of finishing coating (col. 7, lines 62-67). Various methods for determining the amount of materials consumed are described (col. 6, line 42 through col. 7, line 46). **Even if Robinson et al. is interpreted as having both core and enhanced operational resources, the cost in Robinson et al. is calculated even when only “core” operational resources and no “enhanced” operational resources are used.**

For at least the reasons set forth above, Robinson et al. does not describe every element of amended independent claims 1, 9 and 19, and therefore fails to anticipate the subject matter of independent claims 1, 9 and 19. Based on the foregoing, Applicants submit that Robinson et al. cannot support a 35 U.S.C. 102 (b) rejection of claims 1, 9 and 19, and respectfully requests that the rejection be withdrawn.

Each of dependent claims 3, 4, 10-11 and 15 depend from one of independent claims 1 and 9, which are in allowable condition for at least the reasons set forth above. Therefore, dependent claims 3, 4, 10-11 and 15 are also in allowable condition at least by reason of their dependency from an allowable claim. For at least the reasons provided above, Robinson et al. cannot support a 35 U.S.C. 102 (b) rejection of claims 3, 4, 10-11 and 15, and withdrawal of the rejection is respectfully requested.

Claim Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 2 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Pierce (U.S. Patent No. 6,202,057).

Dependent claims 2 and 13 depend from independent claims 1 and 9, respectively. As set forth above, Robinson et al. fails to disclose all of the elements of independent claims 1 and 9. Applicants respectfully submit Pierce fails to remedy the deficiencies of Robinson et

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al., in that Pierce also fails to teach or suggest distinguishing between *core* printer operational resources (i.e., a first resource set) and *enhanced* printer operational resources (i.e., a second resource set), and further fails to teach or suggest a charge calculated *only* as a function of the request for the use or right of use of an enhanced printer operational resource (i.e., a resource of the second set).

Based on the foregoing, Applicants submit that the combination of Robinson et al. and Pierce cannot support a 35 U.S.C. 103(a) rejection and respectfully request that the rejection be withdrawn.

The Examiner has rejected claims 5 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Maruta, et al. (U.S. Patent No. 6,064,838).

Dependent claims 5 and 16 depend from independent claims 1 and 9, respectively. As set forth above, Robinson et al. fails to disclose all of the elements of independent claims 1 and 9. Applicants respectfully submit Maruta et al. fails to remedy the deficiencies of Robinson et al., in that Maruta et al. also fails to teach or suggest distinguishing between *core* printer operational resources (i.e., a first resource set) and *enhanced* printer operational resources (i.e., a second resource set), and further fails to teach or suggest a charge calculated *only* as a function of the request for the use or right of use of an enhanced printer operational resource (i.e., a resource of the second set).

Based on the foregoing, Applicants submit that the combination of Robinson et al. and Maruta et al. cannot support a 35 U.S.C. 103(a) rejection and respectfully request that the rejection be withdrawn.

The Examiner has rejected claims 6 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Hayashi (U.S. Patent No. 6,375,297).

Dependent claims 6 and 17 depend from independent claims 1 and 9, respectively. As set forth above, Robinson et al. fails to disclose all of the elements of independent claims 1 and 9. Applicants respectfully submit Hayashi fails to remedy the deficiencies of Robinson et al., in that Hayashi also fails to teach or suggest distinguishing between *core* printer operational resources (i.e., a first resource set) and *enhanced* printer operational resources (i.e., a second resource set), and further fails to teach or suggest a charge calculated *only* as a

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function of the request for the use or right of use of an enhanced printer operational resource (i.e., a resource of the second set).

Based on the foregoing, Applicants submit that the combination of Robinson et al. and Hayashi cannot support a 35 U.S.C. 103(a) rejection and respectfully request that the rejection be withdrawn.

The Examiner has rejected claims 7, 8 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Nocker (U.S. Patent No. 6,236,486).

Dependent claims 7, 8 and 18 depend from independent claims 1 and 9, respectively. As set forth above, Robinson et al. fails to disclose all of the elements of independent claims 1 and 9. Applicants respectfully submit Nocker fails to remedy the deficiencies of Robinson et al., in that Nocker also fails to teach or suggest distinguishing between *core* printer operational resources (i.e., a first resource set) and *enhanced* printer operational resources (i.e., a second resource set), and further fails to teach or suggest a charge calculated *only* as a function of the request for the use or right of use of an enhanced printer operational resource (i.e., a resource of the second set).

Based on the foregoing, Applicants submit that the combination of Robinson et al. and Nocker cannot support a 35 U.S.C. 103(a) rejection and respectfully requests that the rejection be withdrawn.

The Examiner has rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Sugiura, et al. (U.S. Patent No. 4,393,375).

Dependent claim 12 depends from independent claim 9. As set forth above, Robinson et al. fails to disclose all of the elements of independent claims 9. Applicants respectfully submit Sugiura fails to remedy the noted deficiencies of Robinson et al., in that Sugiura at least fails to teach or suggest that a charge calculated *only* as a function of the request for the use or right of use of an enhanced printer operational resource.

Based on the foregoing, Applicants submit that the combination of Robinson et al. and Freeman cannot support a 35 U.S.C. 103(a) rejection and respectfully requests that the rejection be withdrawn.

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The Examiner has rejected claims 14 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Freeman (U.S. Patent No. 6,134,557).

Dependent claims 14 and 20 depend from independent claims 9 and 19, respectively. As set forth above, Robinson et al. fails to disclose all of the elements of independent claims 9 and 19. Applicants respectfully submit Freeman fails to remedy the deficiencies of Robinson et al., in that Freeman also fails to teach or suggest distinguishing between *core* printer operational resources and *enhanced* printer operational resources, and further fails to teach or suggest a charge calculated *only* as a function of the request for the use or right of use of an enhanced printer operational resource.

Based on the foregoing, Applicants submit that the combination of Robinson et al. and Freeman cannot support a 35 U.S.C. 103(a) rejection and respectfully requests that the rejection be withdrawn.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-20 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-20 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

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The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application. Any inquiry regarding this Amendment and Response should be directed to either Matthew B. McNutt at Telephone No. (612) 767-2510, Facsimile No. (612) 573-2005 or Nathan R. Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958. In addition, all correspondence should continue to be directed to the following address:

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